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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,786	11/13/2000	Alain Marbach	SAA-49	7181

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EXAMINER	
MASINICK, MICHAEL D	

ART UNIT	PAPER NUMBER
2125	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/711,786	MARBACH ET AL.	
	Examiner	Art Unit	
	Michael D Masinick	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-28 are pending in this application. Applicants arguments regarding the USC 112 First Paragraph rejections are not found to be persuasive. Arguments/Amendments related to the USC 112 Second Paragraph are found persuasive and are removed. All other arguments are found non-persuasive.

See additional comments on the 112 rejection below.

Applicants arguments regarding claims 1 and 20 are found to be non-persuasive based entirely on the claim language. While the applicants arguments regarding what is shown in the art references and what is intended by the current application may be correct, the claims are written in a fashion so broad that they can be interpreted in many different ways. It is the examiners opinion that the Coley reference when combined with the Saitoh reference as show to be correct below clearly reads on the claims as written.

Response to Arguments

1. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Coley patent shows all software related claim limitations, only leaving out that this software can be used to run a factory automation system. Since the software used in the

Saitoh patent clearly can be used in the way intended by the software protection system of Coley, these patents are combinable under USC 103.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 10, 11, 12, 23, 24 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the specification says only "a search device, such as a web spider, can be coded" but goes into no detail about how this code would work, does not provide a detailed explanation, and does not provide a preferred embodiment. Examiner asserts that this type of system of searching IP address or MAC addresses close to the address of known pieces of equipment is not well known in the art, thus causing undue experimentation to be preformed in order to re-create the invention claimed in these claims.

3. Applicant argues that "search techniques are taught in the initial freshman class in programming for either Electrical Engineering or Computer Science college curriculums. This statement is wholly false. Examiner has taken such classes, as well as many advanced

programming classes and this type of search system that searches "nearby" IP and MAC addresses would not be able to be programmed without undue experimentation. The issue is not whether one or ordinary skill would be able to program such a system, but that they would be able to program such a system without undue experimentation. The specification in this application goes into absolutely no detail on what a programmer could look for to see if the software is active on a specific IP address or any other information that would further the development of a system that would provide the services of the current invention. This rejections stands as previous cited with this further explaination.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-9, 13-22, and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,790,604 to Cokey et al in view of U.S. Patent No. 6,038,486 to Saitoh et al.

6. Regarding claims 1 and 20, Cokey shows a method of monitoring a product via a communications network, wherein the product includes identifiable information associated therewith, and the factory automation product is installed at an installation site having an installation site address, said method comprising the steps of and means for: obtaining the

installation site address and the identifiable information (Col 8, lines 38-42); and associating the installation site address to the product based on the identifiable information (Col 8, lines 38-42).

7. Cokey does not show that this product is a factory automation product. Saitoh et al clearly shows a factory automation software based product which can be accessed and used over the internet which controls machine tools and a variety of other factory automation efforts.

8. It would have been obvious to one of ordinary skill at the time the invention was made to implement the software security and licensing system of Cokey as the licensing system of Saitoh or any other factory automation software because "A significant amount of software piracy occurs in commercial settings" (Cokey Col 1, lines 8-46).

9. Referring to claim 2, Cokey shows wherein the identifiable information comprises a MAC address assigned to the product (Col 18, lines 10-23). Examiner notes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a MAC address as the ""other suitable hardware identifier" which is clearly shown in Cokey.

10. Referring to claim 3, Cokey shows wherein the identifiable information comprises a serial number ("License ID" – Col 9, lines 52-61 and Col 15, lines 19-20).

11. Referring to claim 4, Cokey shows wherein the identifiable information comprises a version number (Col 9, lines 4-5).

12. Referring to claim 5, Cokey shows wherein the identifiable information comprises a product number (Col 9, lines 1-10).

13. Referring to claim 6, Cokey shows wherein the installation site address is an IP address of the installation site (Col 8, line 42).

14. Referring to claim 7, Saitoh shows where the product is a control device (Figure 1).

15. Referring to claim 8, Cokey clearly shows wherein the product comprises a software product.

16. Referring to claim 9, Cokey shows wherein the product comprises a host computer (Col 7, lines 43-67).

17. Referring to claims 13 and 14, Cokey shows wherein a user of the product is required to register the product over the communications network, and wherein the identifiable information and installation site address is obtained through said registration (Col 8, lines 38-54).

18. Referring to claims 15-17, Cokey shows where the product is provided with an embedded mechanism capable of providing a message or message containing address related information, installation site address information, and identifiable information, said method further comprising the step of receiving the signal in order to obtain the information. Examiner notes that any piece of code is "embedded" into a software product, this Cokey reads on the claims above as written (Col 8, lines 38-54).

19. Referring to claim 18, Saitoh shows wherein the factory automation system is connected to an equipment, said method further comprising the step of identifying the installation site address of the product based on the connected equipment. Examiner notes that Saitoh clearly shows the ability to communicate over a network with equipment in a fashion well known in the art and that identifying the IP address of a piece of equipment would be no different than any other IP address identification system as is well known in the art or shown in Cokey.

20. Referring to claim 19, Saitoh shows where the factory automation product is associated with a URL in the communications network. Examiner notes that Saitoh clearly shows the ability to communicate over a network with equipment in a fashion well known in the art and

that identifying the URL of a piece of equipment would be no different than any other URL identification system as is well known in the art or shown in Cokey.

21. Examiner further notes in regards to claims 18 and 19 that it is well known in the art that URL's and IP addresses are interchangeable as address links to servers or other computer machinery.

22. Referring to claim 21, Cokey shows wherein the providing means comprises a physical site locator ("IP Address", Col 8 line 42).

23. Referring to claim 22, Cokey shows wherein the providing means comprises an embedded device embedded in the factory automation device. See above rejection of claims 15-17. Examiner views the word "embedded" as part of the computer code which is clearly shown in Cokey.

24. Referring to claim 26, Cokey shows means for notifying a user of the factory automation product safety or quality issues using the installation site address (Col 20, lines 53-64).

25. Referring to claim 27, Cokey shows wherein further information is provided when the product is registered, said associating means further associating the product based on the further information (Col 8, lines 38-43).

26. Referring to claim 28, Cokey shows means for determining whether the product is used in violation of licenses based on the installation site address (Col 15, lines 49-62).

Conclusion

27. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

28. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and to the state of the art at the time of invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D Masinick whose telephone number is (703) 305-7738. The examiner can normally be reached on Mon-Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (703) 308-0538. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

mdm

LEO PICARD
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TECHNOLOGY CENTER 2100